

Docket No. 30990156-2 US (1509-144)

RECEIVED
CENTRAL FAX CENTER

PATENT

JUN 07 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	
Inventors: Richard Oliver KAHN et al.	: Confirmation No: 6041
	:
U.S. Patent Application No. 09/788,669	: Group Art Unit: 2612
	:
Filed: February 21, 2001	: Examiner: J. VILLECO
	:
For: PORTABLE INFORMATION CAPTURE DEVICE (as amended)	

SECOND SUBSTITUTE BRIEF ON APPEAL

MailStop POBA
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

Further to the Decision on Petition of April 24, 2006, which indicates that the Evidence Appendix and Related Proceedings Appendix are missing from the previous Brief on Appeal, Appellants' submit herewith a Substitute Brief on Appeal.

To the extent necessary, Appellant hereby requests any required extension of time under 37 C.F.R. §1.136, and hereby authorizes the Commissioner to charge any required fees not otherwise provided for to Deposit Account No. 08-2025.

CERTIFICATION OF FACSIMILE TRANSMISSION
I HEREBY CERTIFY THAT THIS PAPER IS BEING FACSIMILE
TRANSMITTED TO THE PATENT AND TRADEMARK OFFICE
ON THE DATE SHOWN BELOW

Donna L. Lizama
TYPE OR PRINT NAME OF PERSON SIGNING CERTIFICATION
Donna L. Lizama 6-7-06
SIGNATURE DATE
571-273-8300
FACSIMILE NUMBER

Serial No. 09/788,669

RECEIVED
CENTRAL FAX CENTER

JUN 07 2006

TABLE OF CONTENTS

I. Real Party in Interest	5
II. Related Appeals and Interferences	5
III. Status of Claims.....	5
IV. Status of Amendments.....	6
V. Summary of Claimed Subject Matter	6
VI. Grounds of Rejection to be Reviewed on Appeal	9
VII. Argument.....	9
A. Torres does not anticipate claims 1, 17, 13, 14 and/or 25 because, inter alia, Torres does not disclose how far to compress a particular information record on the basis of the priority rating of the particular information record, as required by claim 1, upon which claims 7, 13, 14 and 25 depend.	9
B. Torres does not make obvious the requirement of claim 15, to give a class of information records a common priority rating.	13
C. Torres and Imai et al. do not make obvious the requirements of claim 8 for one, but not the only, option available for handling an image record of Torres to be deletion of the image record only if the image record is stored elsewhere.	13
D. Torres and Saito do not make obvious the requirement of claim 3 for a priority rating to include a maximum permissible compression level for each information record.	15
E. The rejection of claims 4-6, all of which depend either directly or indirectly on claim 3, as being obvious as a result of Torres, Sato and Makishima et al. is wrong.	17
F. Torres and Oie do not render the subject matter of claims 9, 16, 17 and 26 obvious. ...	17

Serial No. 09/788,669

1. Claim 9, that depends on claim 1, distinguishes over Torres and Oie by requiring the portable information record capture device of claim 1 to have an interface for downloading information records from a remote source of such records.	17
2. Independent claim 16, and claims 17 and 26 that depend on it, are improperly rejected as being obvious as a result of Torres and Oie.	17
G. Claim 11, that depends on claim 9, is patentable over the combination of Torres, Oie and Sato because claim 11 requires the priority rating to include maximum permissible compression levels for each information record.	19
H. Claim 12, dependent on claim 11, is not rendered obvious by Torres, Oie, Sato and Makishima et al.	20
VIII. Conclusion.....	20
IX. Claims Appendix.....	22
X. Evidence Appendix.....	28
XI. Related Proceedings Appendix.....	29

Serial No. 09/788,669

TABLE OF AUTHORITIES

Cases

<u>Ex parte Levy</u> , 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990)	12
<u>In re Oelrich</u> , 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).....	12
<u>In re Rijckaert</u> , 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993).....	12
<u>In re Roberston</u> , 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).....	12
<u>In re Vaeck</u> , 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)	16
<u>Wang Laboratories Inc. v. Toshiba Corporation</u> , 993 F.2d 858, 26 USPQ 2d 767 (Fed. Cir. 1993).....	15

Serial No. 09/788,669

I. Real Party in Interest

The real party in interest is Hewlett Packard Development Company, L.P., a Texas limited partnership.

II. Related Appeals and Interferences

There are no related appeals and/or interferences.

III. Status of Claims

No claims are allowed.

Independent claims 19 and 20 are indicated as containing allowable subject matter. In addition, dependent claims 10, 18, 21, 22, 23 and 24, respectively dependent on claims 9, 1, 21, 16 and 23, are indicated as containing allowable subject matter. Claims 8, 10, 19 and 20 are objectionable for language reasons that are perceived by the Examiner. A Letter filed simultaneously with this brief is believed to provide rationale that should satisfy the Examiner and result in removal of the objection to claims 8, 10, 19 and 20. If the Examiner does not remove the objection to claims 8, 10, 19 and 20, Appellants plan to petition the objection.

Claims 1-9, 11-17, 25 and 26 are rejected on the following bases:

Claims 1, 7, 13, 14 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Torres (USP 6,564,282). Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282). Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282), in view of Imai et al. (Japanese Publ. No. 09-128276 A). Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282) in view of Sato

Serial No. 09/788,669

(USP 6,314,206). Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282) in view of Sato (USP 6,314,206) and further in view of Makishima et al. (USP 6,549,307). Claims 9, 16, 17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282) in view of Oie (USP 6,188,431). Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282) in view of Oie (USP 6,188,431) and further in view of Sato (USP 6,314,206). Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282), in view of Oie (USP 6,188,431) and further in view of Sato (USP 6,314,206) and Makishima et al. (USP 6,549,307).

No claims have been canceled.

IV. Status of Amendments

The Supplemental Amendment under Rule 116 filed April 25, 2005 has been entered.

V. Summary of Claimed Subject Matter

The claimed subject matter, as described in connection with Figure 1, inter alia, and defined by claim 1, is directed to a portable information record capture device in the form of digital camera 10 having an information record capture mechanism in the form of photo detector array 12 and a device memory 16 that stores plural information records, each in the form of an optical image captured by photo detector array 12 (page 24, lines 7-9). A controller in the form of microprocessor 14 evaluates the amount of space available in memory 16 (page 26, lines 20 and 21). If memory 16 does not have sufficient space available for an image that has been newly captured by photo detector array 12, one or more of the images stored in memory 16 is compressed or deleted such that sufficient space is available for the newly

Serial No. 09/788,669

captured image (page 26, lines 26-28, page 27, lines 1-5, page 28, lines 4-10, page 27, lines 8-10).

Each image stored in memory 16 has an associated priority rating that can be manually inserted by an operator of the camera or automatically by microprocessor 14 (page 26, lines 5-9, page 29, lines 8-13). In the manual mode, priority ratings are introduced by the user of camera 10 activating selector 26 (page 24, lines 11-13, page 26, lines 6, 7 and 18). Microprocessor 14 selects which information records to compress and how far to compress a particular information record on the basis of the priority rating of the particular information record such that sufficient space is available for the newly captured information record (page 28, lines 14-19, page 29, lines 16-24, page 39, lines 22-26, page 40, lines 1-11). Typically, the extent of compression is in steps, such that, for example, the image is initially compressed by 20% and then compressed again to 40% (page 28, lines 14-19; page 29, lines 18-24).

In the embodiment of Figure 12, as defined by claim 16, index device 1001 includes display 1003 for information records, in the form of images, as captured by camera 1002, that is remotely located from index device 1001 (page 40, lines 12-23). Communications link 1004 receives images captured by camera 1002 and transmits them to index device 1001 that includes memory 16 for storing the images. Index device 1001 also includes a controller that is similar to controller 14, Figure 1. The controller of index device 1001, however, determines if the memory of device 1001 has sufficient space for the newly received image, rather than the newly captured image. Index device 1001 compresses one or more of the images it stores such that sufficient space is available for the newly received image, rather than the newly captured image. As in the embodiment of Figure 1, each image has an associated priority rating. The

Serial No. 09/788,669

controller of index device 1001 selects how far to compress the stored images on the basis of the priority ratings of the stored images.

The priority rating can include a maximum permissible compression level for each image, such that if the image is compressed beyond the maximum permissible compression level, the image becomes worthless (page 30, lines 6-11).

The priority rating can include an indication of whether or not an image is stored elsewhere. If the image is stored elsewhere, the priority rating is relatively low (page 35, lines 4-9). The highest priority level is that the image is not compressible (page 5, lines 2 and 3, page 31, lines 1-6).

As illustrated in Figure 4, camera 10 can be responsive to images stored in computer 42, that couples images to the camera via communications link 44 (page 34, lines 13-23, page 33, lines 16-22, page 31, lines 8-13).

Serial No. 09/788,669

VI. Grounds of Rejection to be Reviewed on Appeal

- A. The rejection of claims 1, 7, 13, 14 and 25 under 35 U.S.C. 102(e) as being anticipated by Torres (USP 6,564,282).
- B. The rejection of claim 15 under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282).
- C. The rejection of claims 2 and 8 under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282), in view of Imai et al. (Japanese Publ. No. 09-128276 A).
- D. The rejection of claim 3 under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282) in view of Sato (USP 6,314,206).
- E. The rejection of claims 4-6 under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282) in view of Sato (USP 6,314,206) and further in view of Makishima et al. (USP 6,549,307).
- F. The rejection of claims 9, 16, 17 and 26 under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282) in view of Oie (USP 6,188,431).
- G. The rejection of claim 11 under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282) in view of Oie (USP 6,188,431) and further in view of Sato (USP 6,314,206).
- H. The rejection of claim 12 under 35 U.S.C. 103(a) as being unpatentable over Torres (USP 6,564,282), in view of Oie (USP 6,188,431) and further in view of Sato (USP 6,314,206) and Makishima et al. (USP 6,549,307).

VII. Argument

A. Torres does not anticipate claims 1, 17, 13, 14 and/or 25 because, inter alia, Torres does not disclose how far to compress a particular information record on the basis of the priority rating of the particular information record, as required by claim 1, upon which claims 7, 13, 14 and 25 depend.

The Examiner, in attempting to show that Torres includes the feature of how far to compress a particular information record, has apparently changed positions. In the Final Rejection, the Examiner relied on column 6, lines 13-32 of Torres (see the second sentence of item 3, page 2 of the Final Rejection). In the Advisory Action, the Examiner relies on Figure 6,

Serial No. 09/788,669

and column 5, lines 55-61, in an attempt show that Torres inherently discloses how far to compress an image file. In fact, neither portion of Torres discloses how far to compress an image file on the basis of a priority rating of a particular image file that is stored in removable memory 354 of Torres. In addition, the Examiner's reliance on inherency is contrary to established law of inherency.

In Torres, there is only one compression step to a predetermined compression level after the image has been stored; see Figure 6, and the description thereof in the paragraph bridging columns 5 and 6. If there is insufficient storage space for a new-image and a first stored image file under consideration has not been compressed to a predetermined level, the first stored file is compressed to the predetermined level. If the first stored image file has been compressed to the predetermined level, a second stored image file is examined to determine if it is to be compressed. If the second file is to be compressed, the second file is compressed. If no additional files need compressing, the storage recovery procedure is completed. There are no do over loops in Figure 6, to provide additional compression levels.

The paragraph bridging columns 5 and 6 indicates the images, as initially loaded into memory 354, are usually compressed to a predetermined compression level, i.e., the images are compressed prior to ever being applied to removable memory 354. The further compression referred to in connection with Figure 6 is the compression associated with wavelet compression.

The first full paragraph in column 6 of Torres does not indicate Torres selects how far to compress a particular image record on the basis of a priority rating. Instead, Torres uses the priority referred to in the first full paragraph of column 6 to determine which image records are

Serial No. 09/788,669

to be compressed to the predetermined level. Thus, the highest priority candidates for further compression are initially compressed to the predetermined level. If additional memory space is required, lower priority candidates for further compression are compressed to the predetermined level. Thus, Torres uses priority levels to determine which image records are to be compressed to the predetermined level, not how far to compress a particular image record.

The Advisory Action states that Torres inherently determines how far to compress an image file if it has not already been compressed to a predetermined level. However, the Advisory Action provides no adequate basis for the conclusion that Torres inherently determines how far to compress an image file based on the priority rating of a particular information record. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); In re Oelrich, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Roberston, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990). Since the Examiner has not provided a rationale or evidence to show that the digital camera of Torres inherently determines how far to compress an image file, the reliance on inherency is incorrect.

Serial No. 09/788,669

Since Torres does not anticipate claim 1, upon which claims 7, 13, 14 and 25 depend, these dependent claims are allowable with claim 1.

Torres does not disclose the feature of claim 25, requiring the controller to compress the particular information record by a variable amount on the basis of the priority rating of the particular information record. Again, the Examiner's positions in the Final Rejection and the Advisory Action are different for claim 25. Item 16, page 5, of the Final Rejection states Torres discloses variable compression because Torres discloses an image can be compressed or not compressed. The Examiner says this is compressing by a variable amount. The Examiner apparently realized the position set forth in the Final Rejection is completely illogical. Consequently, the Advisory Action states Torres discloses variable compression because the image is JPEG compressed or further compressed to the predetermined level.

The Advisory Action is as incorrect as the Final Rejection. The JPEG compression occurs in Torres before the image is stored (column 5, lines 62-65). Hence, the JPEG compression has nothing to do with the priority rating of the image, as claim 25 requires. In Torres, the further compression is to the predetermined level or not at all. The deletion of an image can not be considered as compression, as pointed out by the Examiner in the paragraph of the Advisory Action commenting on appellants' amendment to claims 8, 10 and 18-20. Since Torres only has compression to the predetermined level, the requirement of claim 25 for variable compression on the basis of a priority rating of a particular information record is not found in Torres.

Serial No. 09/788,669

B. Torres does not make obvious the requirement of claim 15, to give a class of information records a common priority rating.

Page 6, item 19 of the Final Rejection states incorrectly that Torres discloses all limitations of claim 1, upon which claim 15 depends. In this regard, see section A of the Argument section of this Brief. The Office Action admits Torres fails to disclose giving a common priority rating to a class of information records, as defined by claim 15. While it is known in the art to group similar images into categories, the grouping in the past has typically been for the convenience of a user, so a user can easily retrieve images relating to the same thing. Such grouping has nothing to do with saving time and effort of a camera processor. Consequently, one of ordinary skill in the art would not have modified Torres so the same priority rating is given to stored images of the same class. There is no basis from the Torres reference or the prior art that a group of tagged images would be given a common priority rating in the Torres compression scheme. The Examiner relies on hindsight for his position.

C. Torres and Imai et al. do not make obvious the requirements of claim 8 for one, but not the only, option available for handling an image record of Torres to be deletion of the image record only if the image record is stored elsewhere.

Claims 2 and 8 depend on claim 1 and, therefore, are allowable with claim 1 because Imai et al. does not cure the deficiencies in the rejection of claim 1.

Concerning the deletion requirement of claims 2 and 8, Appellants admit digital cameras are frequently manually operated so an image file is deleted and that memory space is thus preserved. Hence, reliance on Imai et al. for the deletion feature, as most broadly encompassed by claim 2, is not necessary.

The combination of Torres and Imai et al. is wrong. Item 21, bridging pages 6 and 7 of the Final Rejection, admits Torres fails to disclose one option for handling information record

Serial No. 09/788,669

to be deletion of the information record. (The last full sentence on page 6 of the Final Rejection incorrectly implies that claims 2 and 8 require a form of compression to be deleting an image data record. However, claims 2 and 8 do not state deletion is compression.) One of ordinary skill in the art would not have modified the Torres digital camera as a result of the Imai et al. reference. Imai et al. is directed to a computer system and file managing method using a computer system. If recording medium 3 (which appears to be a disk or tape drive) has inadequate space for a new file to be recorded on medium 3, a file recorded on medium 3 of lesser importance is erased. One of ordinary skill in the digital camera art, to which Torres is devoted, would not have looked to the art concerned with computer systems, particularly computer systems including disk or tape drives, to increase the storage capacity of the digital camera. As is well known, the memories of digital cameras are semiconductor devices, i.e., devices that are entirely different from the memories of the type disclosed by the Imai et al. reference. Hence, Imai et al. is in a different field of endeavor from Torres.

The situation concerning the combination of Torres et al. and Imai et al. is similar to that set forth in Wang Laboratories Inc. v. Toshiba Corporation, 993 F.2d 858, 26 USPQ 2d 767 (Fed. Cir. 1993). In Wang v. Toshiba, the claims were directed to single inline memory modules (SIMMs) for installation on a printed circuit mother board for use in personal computers. Reference to a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because both related to memories. The reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes can be added or replaced. In contrast, the claims under consideration employed only compact modular memories. The memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories

Serial No. 09/788,669

(which Torres mentions). In contrast, the SIMM of the reference was developed for use in large industrial machine controllers and were only disclosed in connection with static random access memories or read-only-memories. Clearly, the Imai et al. computer system including a tape or disc drive would not be employed in a portable information record capture device having an information record capture mechanism, as required by appellants' claims 2 and 8.

Claim 8 includes the additional requirement that deletion of an information record by the controller is only permissible if the information record is stored elsewhere. The Advisory Action, antepenultimate paragraph of page 2, relies on the statement in column 6, line 20 of Torres that images that have been already archived are compressed sooner than images that have not been archived. The Torres disclosure indicates the unobviousness of deleting an archived image from the Torres memory. Torres did not realize that deletion of an archived image would assist in providing the desired increased memory space. Torres was focused only on compressing to a predetermined level, and never realized that additional memory space could be freed by deleting the image that was already archived. Clearly, the combination of Torres and Imai et al. to reject claim 8 is a result of hindsight gleaned from Appellants' disclosure, rather than the prior art. In re Vaeck, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

D. Torres and Saito do not make obvious the requirement of claim 3 for a priority rating to include a maximum permissible compression level for each information record.

Claim 3 is allowable with claim 1, upon which claim 3 depends because Saito does not cure the foregoing deficiencies of Torres.

Serial No. 09/788,669

Item 24, in the paragraph bridging pages 7 and 8 of the Final Rejection, says Torres discloses maintaining the quality of specific images may be important to a user. While appellant can find no statement supporting this position in Torres, column 6, lines 23-25, of Torres indicates certain files are tagged as unavailable for compression beyond the JPEG compression that is initially applied to the images prior to the images being stored. The images that are tagged as unavailable for further compression are those images in which it is desired to maintain the quality of the image. However, this is a far cry from selecting how far to compress a particular image on the basis of a priority rating, such that the priority rating includes the maximum permissible compression level for each image, as would be required to reject claim 3. The reliance on Sato for this feature is misplaced. Sato has no disclosure of priority ratings. Since Torres has no disclosure of selecting how far to compress a particular information record on the basis of a priority rating of a particular image, one of ordinary skill in the art would not have looked to the Sato disclosure to provide maximum permissible compression levels for the image records of Torres.

Further, Figure 4 of Sato et al., relied on by the Examiner to disclose the missing link of Torres, is merely directed to setting a maximum compression ratio in response to a quality mode set by a user of a digital camera. Sato et al. has nothing to do with priority ratings. The Examiner, in combining Sato et al. with Torres has merely cast about to find what he perceives to be different features of appellants claim 3. Such combinations of the prior art are completely inappropriate.

Serial No. 09/788,669

E. The rejection of claims 4-6, all of which depend either directly or indirectly on claim 3, as being obvious as a result of Torres, Sato and Makishima et al. is wrong.

Makishima et al., like Sato, does not cure the deficiencies of claim 1 with regard to Torres et al., as discussed *supra*. Hence, claims 4-6 are patentable for the same reasons advanced for claims 1 and 3, upon which claims 4-6 depend.

F. Torres and Oie do not render the subject matter of claims 9, 16, 17 and 26 obvious.

1. Claim 9, that depends on claim 1, distinguishes over Torres and Oie by requiring the portable information record capture device of claim 1 to have an interface for downloading information records from a remote source of such records.

Oie does not cure the deficiencies of claim 1, upon which claim 9 depends. Consequently, the rejection of claim 9 as being obvious as a result of Torres and Oie is wrong.

Oie merely discloses, and is relied on by the Examiner, for the disclosure of camera 1a sending selected images to camera 1b by using communication terminals 47. Communication terminals 47 of each camera are connected to each other by communication cable 69. Oie, however, has nothing to do with selecting how far information records are to be compressed on the basis of a priority rating of a particular information record. Hence, the rejection of claim 9 as being obvious from Torres et al. is wrong.

2. Independent claim 16, and claims 17 and 26 that depend on it, are improperly rejected as being obvious as a result of Torres and Oie.

To reject the memory, controller, priority rating and selecting how far to compress a record on the basis of a priority ratings of the records, the Examiner relies on Torres; see the

Serial No. 09/788,669

paragraph bridging pages 9 and 10 of the Office Action. The rationale is very similar to that relied on by the Examiner to reject somewhat similar features of claim 1, except that in the rejection of claim 16, the Examiner alludes to Torres disclosing a system that looks at a file extension to determine the level of compression. Apparently, the reference to a file extension concerns the first full sentence of column 6 of Torres which merely indicates the level of compression is identified by a file extension that indicates compression, such as ".jpg" for JPEG files. In Torres, the identification of the compression level can also be determined by looking at a file header. However, Torres does not have a controller for selecting how far a record is to be compressed on the basis of priority ratings of the records. Instead, the relied on portion of Torres merely means the image record compression, at the time the image record is initially stored, has a compression indicated by a file extension or by looking at the file header. Such compression is not based on an evaluation of available space in the device memory, but is preset by the user.

As previously discussed Oie does not cure the aforementioned deficiencies of Torres. Consequently, one of ordinary skill in the art would not have modified Torres to compress the images that camera 1a transmits to camera 1b if sufficient space is not available for a newly received image in camera 1b, such that camera 1b would select how far to compress the image record received from camera 1a on the basis of priority ratings of the information records.

Claim 17 depends on claim 16 and is allowable therewith. In addition, claim 17 requires the priority rating of a newly received information record to be calculated by the controller according to predetermined criteria. As item 32, page 10 of the Final Rejection indicates, in Torres a user sets a priority rating. The user tags certain files as the highest priority candidates for further compression and tags other files as unavailable for further

Serial No. 09/788,669

compression, i.e., compression greater than the compression that the image underwent prior to being stored in the memory. Torres has no disclosure of priority ratings being calculated by any controller or by central processing unit (CPU) 344. The Examiner states CPU 344 would have to do some type of calculation to associate a user tag with an image. However, such a calculation is speculation on the part of the Examiner. In addition, claim 17 requires the priority rating to be calculated by a controller according to predetermined criteria. There is simply no disclosure in Torres of such a requirement.

If the Examiner apparently is relying on inherency to reject claim 17, he has not met the burden of proving inherency, as set forth in the prior discussion about inherency in this brief.

Claim 26 is allowable for the same reasons advanced for claim 16, upon which it depends. In addition, claim 26 requires the information record to be compressed by a variable amount. To reject claim 26, the Examiner, in item 33, at the bottom of page 10, states that compressing an image or not compressing an image causes an image to be compressed by a variable amount. Appellants can not agree. Compression by a variable amount means that under certain circumstances, an image is compressed by a different amount from what it is compressed under other circumstances.

G. Claim 11, that depends on claim 9, is patentable over the combination of Torres, Oie and Sato because claim 11 requires the priority rating to include maximum permissible compression levels for each information record.

Claim 11 is allowable for the same reasons as advanced for claims 1 and 9, upon which claim 11 depends. In addition, as discussed *supra* in connection with claim 3 (see part D of the Argument), Torres and Sato do not render obvious the feature of each information record having a priority rating with a maximum permissible compression level.

Serial No. 09/788,669

H. Claim 12, dependent on claim 11, is not rendered obvious by Torres, Ole, Sato and Makishima et al.

Claim 12 is patentable for the same reasons advanced for claim 11, upon which it depends.

VIII. Conclusion

Torres does not anticipate claim 1 or cause claim 16 to be obvious because Torres does not disclose a controller for selecting how far to compress a particular information record on the basis of a priority rating of the particular information record. The Advisory Action indicates the Examiner relies on inherency of Torres for the foregoing feature. However, the Examiner has not shown that Torres necessarily includes a controller for selecting how far to compress a particular information record on the basis of a priority rating of the particular record. The Examiner has not provided a proper rationale or evidence to support his position. In addition, Torres indicates that an image record, once stored, is only compressed to a predetermined level. Priority is employed by Torres to determine which image records are to be compressed to the predetermined level, not how far an image record is to be compressed.

The allegation that Torres discloses the feature of compressing a particular information record by a variable amount on the basis of the priority rating of the particular information record, as defined by claims 25 and 26, is incorrect. The Examiner's statement that "variable compression is either leaving the stored image as a JPEG image without further compression or further compressing the image to the predetermined level" is incorrect. Variable compression means the compression can have multiple values, not merely a single predetermined value.

Serial No. 09/788,669

One of ordinary skill in the art would not have combined Imai et al. with Torres to arrive at the combination of claim 8. Torres recognizes that archived files, i.e., files stored elsewhere, are the highest priority candidates for further compression. However, Torres did not realize that maximum memory space saving could be achieved merely by deleting these archived image records. The reliance on Imai et al. for this feature is incorrect because of Imai et al. is not concerned with digital cameras, the technology to which Torres et al. is directed. Further, Imai et al. does not appear to say anything about records that are stored elsewhere.

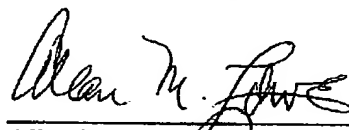
The remaining claims are allowable with the claims upon which they depend and for other reasons, as set forth in the remainder of this Brief.

Based on the foregoing, reversal of the various rejections are in order.

Respectfully submitted,

Richard Oliver KAHN et al.

By:



Allan M. Lowe
Reg. No. 19,641

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400
Telephone: 703-684-1111
Facsimile: 970-898-0640

Date: June 7, 2006

AML:dll

Docket No. 30990156-2 US (1509-144)

PATENT**IX. Claims Appendix**

1. A portable information record capture device having:

an information record capture mechanism;

a device memory adapted to store a plurality of information records;

a controller adapted to evaluate space available in the device memory, and if sufficient space is not available for a newly captured information record, to compress one or more of the information records such that sufficient space is available for the newly captured information record;

wherein each information record has an associated priority rating; whereby the controller is adapted to select which information records to compress and how far to compress a particular information record on the basis of the priority rating of said particular information record.

2. A portable information record capture device as claimed in claim 1, wherein one, but not the only, option available for handling of an information record is deletion of the information record.

3. A portable information record capture device as claimed in claim 1, wherein said priority rating includes the maximum permissible compression levels for each information record.

4. A portable information record capture device as claimed in claim 3, wherein said maximum permissible compression level for each record is defined to be suitable for defined functional purposes of each record.

Serial No. 09/788,669

5. A portable information record capture device as claimed in claim 4, wherein the portable information record capture device is a camera and one defined functional level is suitability for printing at a predetermined resolution.
6. A portable information record capture device as claimed in claim 4, wherein the portable information record capture device is a camera and one defined functional level is suitability for viewing at the resolution of a display of the camera.
7. A portable information record capture device as claimed in claim 1, wherein said priority rating includes an indication of whether or not an information record is stored elsewhere.
8. A portable information record capture device as claimed in claim 7, wherein one, but not the only, option available for handling of an information record is deletion of the information record, and deletion of an information record by the controller is only permissible if the information record is stored elsewhere.
9. A portable information record capture device as claimed in claim 1, further comprising an interface for downloading information records from a remote source of information records.
10. A portable information record capture device as claimed in claim 9, wherein one, but not the only, option available for handling of an information record is deletion of the information record, and deletion of an information record by the controller is only permissible if the information record is a downloaded information record.

Serial No. 09/788,669

11. A portable information record capture device as claimed in claim 9, wherein said priority rating includes maximum permissible compression levels for each information record.
12. A portable information record capture device as claimed in claim 11, wherein said maximum permissible compression level for each record is defined to be suitable for defined functional purposes of each record.
13. A portable information record capture device as claimed in claim 1, wherein an available priority rating for an information record is that the information record is not compressible.
14. A portable information record capture device as claimed in claim 1, further comprising a user interface whereby a user can determine a priority rating for an information record.
15. A portable information record capture device as claimed in claim 1, whereby a class of information records are given a common priority rating.
16. An index device for display of remotely captured information records, comprising:
 - a communications link for receiving information records captured at a remote information record capture device;
 - a device memory adapted to store a plurality of information records;
 - a controller adapted to evaluate space available in the device memory, and if sufficient space is not available for a newly received information record, to compress one or more of the information records such that sufficient space is available for the newly received information record;

Serial No. 09/788,669

wherein each information record has an associated priority rating; whereby the controller is adapted to select which information records to compress and how far to compress them on the basis of the priority ratings of said information records.

17. An index device as claimed in claim 16, wherein the priority rating of a newly received information record is calculated by the controller according to predetermined criteria.

18. A portable information record capture device as claimed in claim 1, wherein one, but not the only, option available for handling of an information record is deletion of the information record, and deletion of an information record by the controller is only possible if the information record is a downloaded information record.

19. A portable information record capture device having:

an information record capture mechanism;

a device memory adapted to store a plurality of information records;

a controller adapted to evaluate space available in the device memory, and if sufficient space is not available for a newly captured information record, to compress one or more of the information records such that sufficient space is available for the newly captured information record;

wherein one, but not the only, option available for handling of an information record is deletion of the information record, and each information record has an associated priority rating; whereby the controller is adapted to select which information records to compress and how far to compress them on the basis of the priority ratings of said information records;

Serial No. 09/788,669

an interface for downloading information records from a remote source of information records; and

wherein deletion of an information record by the controller is only permissible if the information record is a downloaded information record.

20. A portable information record capture device having:

an information record capture mechanism;

a device memory adapted to store a plurality of information records;

a controller adapted to evaluate space available in the device memory, and if sufficient space is not available for a newly captured information record, to compress one or more of the information records such that sufficient space is available for the newly captured information record;

wherein one, but not the only, option available for handling of an information record is deletion of the information record, and each information record has an associated priority rating; whereby the controller is adapted to select which information records to compress and how far to compress them on the basis of the priority ratings of said information records; and

wherein deletion of an information record by the controller is only permissible if the information record is a downloaded information record.

21. The portable information record capture device of claim 1, wherein the priority is based on expected use of the information record.

Serial No. 09/788,669

22. The portable information record capture device of claim 21, wherein the controller is adapted to compress the particular information record by a variable amount on the basis of the expected use of said particular information record.

23. The portable information record capture device of claim 16, wherein the priority is based on expected use of the information record.

24. The portable information record capture device of claim 23, wherein the controller is adapted to compress the particular information record by a variable amount on the basis of the expected use of said particular information record.

25. The portable information record capture device of claim 1, wherein the controller is adapted to compress the particular information record by a variable amount on the basis of the priority rating of said particular information record.

26. The portable information record capture device of claim 16, wherein the controller is adapted to respond to the priority rating of said particular information record to compress the particular information record by a variable amount on the basis.

Serial No. 09/788,669

X. Evidence Appendix

None.

Serial No. 09/788,669

XI. Related Proceedings Appendix

None.